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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/010,630  
Filing Date: November 07, 2001  
Appellant(s): TOYOMURA ET AL.

\_\_\_\_\_  
Lawrence A. Ashery  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 6, 2009 appealing from the Office action mailed July 8, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,341,196	ANDO et al.	01-2002
7,103,602	BLACK et al.	09-2006
U.S. 2005/0219559	ITO et al.	10-2005

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-6, 8, 14 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Ando et al (U.S Patent 6,341,196).

Claims 12, 15-31,34-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al (U.S Patent 6,341,196) in view of Black et al (US patent 7103602 B2) (hereinafter "Black").

Claims 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al (U.S Patent 6,341,196) in view of Black et al (US patent 7103602 B2) (hereinafter "Black") and further in view of Ito et al (US Patent Application Pub. No. 2005/0219559 A1).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3-6, 8, 14 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Ando et al (U.S Patent 6,341,196).

As per claim 1, Ando disclose [a] memory media for storing data for access by an application program being executed on a data processing system comprising (Fig. 11, col. 15, lines 37-63):

**a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats, so that not more than said respective one of said plurality of file formats are permitted to be stored in each of said directories** (Fig. 5, col. each 5, lines 7-15, col. 17, lines 7-26, a directory stores its own data type that is video directory stores video file, still picture directory stores still picture file, audio directory stores audio file);

**a further directory at said directory level, said further directory for storing files in other than said plurality of file formats** (Fig. 5, user-set subdirectory).

As per claim 3, Ando teaches wherein said directory level is immediately under a root directory (Fig. 5, directories are listing under the root directory).

As per claim 4, Ando teaches wherein said the memory media are memory card (Fig. 11, col. 15, lines 37-53)

As per claim 5, Ando teaches wherein said further directory is further for storing files in one of said plurality of file formats (Fig. 5, user-set directory).

As per claim 6, Ando discloses a **portable information terminal comprising memory for storing data for access by an application program being executed by said terminal and detachable to and from a terminal body of the information terminal comprising** (Fig. 11, col. 15, lines 37-63):

**means for forming a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats, so that not more than said respective one of said plurality of file formats are permitted to be stored in each of said directories** (Fig. 5, col. each 5, lines 7-15, col. 17, lines 7-26, a directory stores its own data type that is video directory stores video file, still picture directory stores still picture file, audio directory stores audio file);

**a further directory at said directory level, said further directory for storing files in other than said plurality of file formats** (Fig. 5, user-set subdirectory).

As per claim 8, Ando discloses a **portable information terminal comprising carryable memory media for storing data for access by an application program being executed by said terminal and detachable to and from body of the terminal** (Fig. 11, col. 15, lines 37-63),

**wherein said carryable memory media is provided with a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats, so that not more than said**

**respective one of said plurality of file formats are permitted to be stored in each of said directories** (Fig. 5, col. each 5, lines 7-15, col. 17, lines 7-26, a directory stores its own data type that is video directory stores video file, still picture directory stores still picture file, audio directory stores audio file);

**a further directory at said directory level, said further directory for storing files in other than said plurality of file formats** (Fig. 5, user-set directory)

**if a file to be stored conforms to said plurality of directories, said portable information terminal stores the relevant file in the carryable memory media at a data area corresponding to one of said plurality of file formats, if a file to be stored does not conform to said portable information terminal stores the file in the carryable memory media at a further data area corresponding to said further directory** (Fig. 5, col. 17, lines 1-26, each directory is assigned a unique directory name and file name corresponding to each collection of file data and stored in said unique directory name).

As per claim 14, Ando teaches an operation section for operation by a user, wherein based on operation by said user of the operation section, at least one file is stored in a data area corresponding to said plurality of directories and at least another file is stored in a further data area corresponding to said further directory (Fig. 11, Fig. 5).

As per claim 32, Ando discloses **[a] method for managing files in a portable information terminal comprising carryable memory media for storing data for access by an application program being executed by said**

**terminal and detachable to and from body of the terminal** (Fig. 11, col. 15, lines 37-63), comprising the steps of:

**A) forming a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats, so that not more than said respective one of said plurality of file formats are permitted to be stored in each of said directories** (Fig. 5, col. each 5, lines 7-15, col. 17, lines 7-26, a directory stores its own data type that is video directory stores video file, still picture directory stores still picture file, audio directory stores audio file);

**B) forming a further directory at said directory level said further directory for storing files in other than said plurality of file formats** (Fig. 5, user-set directory)

**C) storing a file in said carryable memory media at a data area corresponding to one of said plurality of directories or said further directory** (col. 17, lines 1-26, collections of file data are stored in the assigned directory name corresponding to file name).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12, 15-31, 34-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al (U.S. Patent 6,341,196) in view of Black et al (US patent 7103602 B2) (hereinafter "Black").

As per claim 12, Ando does not explicitly teach, but Black teaches wherein an attached file attached to electronic mail received is stored in said carryable memory media at a data area corresponding to said further directory (Fig. 3, element 56). Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to combine the teachings of the cited references to allow the attached file attached to electronic mail received is stored in said carryable memory media at a data area corresponding to said further directory as disclosed by Black because it would improve data management system to organize and process a large volume of various types of data files and provide efficient way of reviewing and manipulate the data stored in specific directory, as suggested by Black (col. 2, lines 1-4) and Ando (col. 4, lines 1-25)

As per claim 15, Black teaches separation means for separating an e-mail with the attached file received through said communication means into the e-mail document file and the attached file (Fig. 3, element 56), wherein

said e-mail document file is stored in said carryable memory media at a data area corresponding to one of said plurality of formats (col. 6, lines 49-52), and

said attached file is stored in said carryable memory media at a data area corresponding to other than said plurality of formats (col. 6, lines 55-56).

As per claim 16, Black teaches wherein storage of said e-mail document file and said attached file is based on operation of a user (col. 5, lines 4-5).

As per claim 17, Black teaches file extraction means for extracting said files (col. 6, lines 57-64).

As per claim 18, Black teaches control means, wherein said control means controls at least one process among the following processes to be performed on said extracted file for deleting the file, shifting the file to a data area of said carryable memory media, which data area corresponding to a different directory other than the original directory, and storing it in there, transmitting the file as an attached file; and exhibiting it on a display (Fig. 2, element 44, de-duplicating).

As per claim 19, Black teaches wherein said file extraction means extracts the file that conforms to said specific file form, based on the file expansion index (col. 7, lines 10-25).

As per claim 20, Black teaches wherein said file extraction means extracts the file that conforms to said specific file form, based on the file inner structure (col. 7, lines 10-25).

As per claim 21, Black teaches wherein said file extraction means extracts the file that conforms to said specific file form, through a plurality of steps of extraction (col. 7, lines 10-25).

As per claim 22, Black teaches input means for inputting conditions for file extraction, wherein said file extraction means extracts, among those which conform to said specific file form, the file that satisfies said conditions for file extraction (col. 7, lines 1-9).

As per claim 23, Black teaches control means, wherein said control means controls at least one process among the following processes to be performed on said extracted file, for deleting the file; shifting the file to a data area of said carryable memory media, which data area corresponding to a different directory other than the original directory, and storing it in there; transmitting the file as an attached file; and exhibiting it on a display (Fig. 2, element 44).

As per claim 24, Black teaches wherein said file extraction means extracts the file that conforms to specific file form through the following process; a primary extraction based on the file expansion index, and an extraction once again based on the inner structure of those extracted by said primary extraction (Fig. 3, element 56, 58, e-mail file type and attached data file type).

As per claim 25, lida teaches a video processing function, said directory for storing specific format files containing a directory for storing video information form files, wherein a video information file is extracted from both of the data areas of said carryable memory media; one data area is that which corresponds to the directory for storing video information form files and the other data area is that which corresponds to said directory for storing non-specific format files (col. 17, lines 30-51).

As per claim 26, Black teaches terminal extracts the Exif format image file through either one of the following processes; extracting the JPG image file from data area of said carryable memory media based on the directory for storing non-specific format files, or extracting the image file from said carryable memory media based on the JPG expansion index . jpg of the directory for storing non-specific format files; and a process of checking the Inner structure of said image file extracted (col. 8, lines 35-67).

As per claim 27, Black teaches information terminal prints the extracted Exif format file upon an operation made by a user (col. 9, lines 20-22).

As per claim 28, Black teaches wherein the portable Information terminal transmits the attached file stored in a data area corresponding to said further directory via said communication means, accompanying an e-mail (col. 6, lines 47-52).

As per claim 29, Black teaches wherein said file control means deletes a file which had been stored in a data area corresponding to said further directory after it is transmitted via said communication means (Fig. 2, # 44, de-duplicating).

As per claim 30, Black teaches wherein said file control means shifts a file that had been stored in a data area corresponding to said directory for storing non-specific format files after it was transmitted via said communication means, to a data area of said carryable memory media that corresponds to a certain directory other than said original directory for storing specific format files and said original directory for storing non-specific format files (a master user list, folder directory (root), col. 6, lines 49-50).

As per claim 31, Black teaches wherein said instruction means issues one of the following instructions based on operation of the operation section by a user, after a file stored in a data area corresponding to said directory for storing non-specific format files is transmitted via said communication means, regarding how the transmitted file be handled:

leaving the transmitted file in said directory for storing non-specific format files; deleting the transmitted file; shifting the transmitted file to a data area of said carryable memory media that corresponds to a certain specific directory other than said original directory for storing specific format files and said original directory for storing nonspecific format files (Fig. 2, de-duplicating, a master user list, folder directory (root), col. 6, lines 49-50).

Claims 34-43, 50, 51, 58 have similar limitations as claims 12, 15-24, therefore, they are rejected under the same subject matter.

Claims 46-48 have similar limitations as claim 3, therefore, they are rejected under the same subject matter.

Claim 49 is rejected under the same rationale as stated in claim 6 argument.

Claims 52, 53, 56, 54, 55 and 57 are rejected under the same rationale as stated in claim 1 arguments.

Claims 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al (U.S Patent 6,341,196) in view of Black et al (US patent 7103602 B2) (hereinafter "Black") and further in view of Ito et al (US Patent Application Pub. No. 2005/0219559 A1).

Ando and Black do not explicitly teach wherein the portable Information terminal is a portable telephone unit. But Ito teaches the portable Information terminal is a portable telephone unit (para. 0140). Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to combine the teachings of the cited references to implement the portable Information terminal is a portable telephone unit because it would provide users of Ando's system and Black's system to retrieve and/or transmit a file (picture) from a small directory (memory card's directory from the mobile phone) even without a digital camera.

Claim 45 has similar limitation as claim 44, therefore, it is rejected under the same subject matter.

#### **(10) Response to Argument**

1). Ando's Fig. 5 discloses each individual directory (folder): ("Rewritable video title set RWV\_TS", "Video title set VIDEO\_TS", "Audio title set AUDIO\_TS", and "USER-SET subdirectory") appear under a "ROOT DIRECTORY" which allows each directory stores files in its own data type format (see Appellant's brief page 7, last paragraph, page 8, first and second paragraphs).

Appellants argue that Ando et al. do not disclose or suggest the Appellants' claimed features a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats and a further directory at said directory level ... for storing files in other than said plurality of file formats, as required by claim 1 because "Ando is silent with respect to limiting the video title set and audio title set to one format" (emphasis added).

The Examiner respectfully disagrees with Appellants' arguments. Ando discloses that a video file containing video information, a still picture file containing still picture information, and an audio file containing audio information is recorded on an information storage medium (e.g., an optical disk) (col. 5, lines 7-11). Particularly, Ando's Fig. 5, as shown on its face, the Root Directory is **divided into a plural of partitions** (subdirectories), each partition (subdirectory) contains a collection of file data (col. 17, lines 53-58). Ando further discloses that **to distinguish one collection of file data**

**from another**, each collection of file data is assigned a unique file name or **each directory is assigned a unique directory name** so that collection of file data is **placed under which directory** each collection of file data is recorded (col. 17, lines 3-9, 20-22). Therefore, by looking at the nature of Fig. 5 (without further looks into Ando's specification), we can see the root directory is partitioned into a plural of subdirectories and **each subdirectory is named with a unique subdirectory name**, such as a Rewritable video title set RWV\_TS subdirectory, a Video title set VIDEO\_TS subdirectory, a Audio title set AUDIO\_TS subdirectory, and a USER-SET subdirectory. Consequently, a video file containing video information is recorded under subdirectory which has been partitioned for its purposes and with a given unique directory name: Video title set VIDEO\_TS, or an audio file containing audio information is recorded under subdirectory has been partitioned for its purposes and with a given unique directory name: Audio title set AUDIO\_TS, and a USER-SET is recorded another file data (other than audio or video file formats) under subdirectory which has been partitioned for its purposes and with a given unique directory name: USER-SET subdirectory. All the followings pieces of collections of file data are recorded on an information storage medium (e.g., an optical disk) (col. 5, lines 7-11) under which directory each collection of file data is recorded (col. 17, lines 20-22). From the above passages, Ando does teach the recited claimed features a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats and a further directory at said directory level ... for storing files in other than said plurality of file formats.

In the event that the honorable Board of Appeals finds that Ando inadequately discloses the claimed step of each of said directories limited to storing files of a respective one of a plurality of file formats, so that not more than said respective one of said plurality of file formats are permitted to be stored in each of said directories, the Examiner fails to see the inventive steps for patent subject matter eligibility as recited by claim 1 because it is directed to either **“functional descriptive material”** or **“nonfunctional descriptive material”**.

MPEP 2106.01 [R-6] Computer-Related Nonstatutory Subject Matter

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759.

As it has been discussed, the features recite in claim 1 is just a required statement that each directory limited to store respective one of a plurality of file formats. The plurality of file formats stores in each directories are just a **listing** of descriptive material *per se* and hence nonstatutory.

2). Ando et al. does teach the claimed features recite in independent claims 6, 8 and 32 (see Appellants' brief page 8, 4th paragraph).

With regards to independent claims 6, 8 and 32, Appellants make a general statement that claims 6, 8 and 32 are similar to independent claim 1 and are patentable over the cited art for at least the same reasons as claim 1. In response, for the same reasons discussed above regarding claim 1, patentability is therefore urged to be based upon the same analysis previously set forth with respect to the rejection of claim 1, the examiner has found unpersuasive.

3). Ando et al. in view of Black et al. do teach the claimed features recite in independent claims 49 and 52-57 (see Appellants' brief page 8, last paragraph).

With regards to independent claims 6, 8 and 32, Appellants make a general statement that claims 49 and 52-57 are similar to independent claim 1 and are patentable over the cited art for at least the same reasons as claim 1. In response, for the same reasons discussed above regarding claim 1, patentability is therefore urged to be based upon the same analysis previously set forth with respect to the rejection of claim 1, the examiner has found unpersuasive.

Therefore, depend claims 3-5, 12, 14-31, 34-48, 50, 51 and 58 include all of the limitations of respective claims from which they depend are found unpatentable over the cited arts for at least the same reasons set forth above.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

### **Conclusion**

The reference discloses the claimed features a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats and a further directory at said directory level ... for storing files in other than said plurality of file formats. In light of the forgoing arguments, the examiner respectfully requests the honorable Board of Appeals and Interference to sustain the rejection.

Respectfully submitted,

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June 4, 2009.

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